



Express Mail No.: EV 534 877 215 US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Liaw *et al.*

Confirmation No.: 2900

Serial No. 09/839,768

Group Art Unit: 2112

Filed: April 19, 2001

Examiner: Myers, Paul R.

For: *High-Frequency Bus System*

Attorney Docket No.: 060809-0080-US

RENEWED PETITION UNDER 37 CFR 1.78(A)(3)

Mail Stop Amendments
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The present Request for Continued Examination (RCE) is filed together with the following documents:

1. Applicant's Petition for Acceptance of Unintentionally Delayed Claim for Priority, filed January 12, 2005 (*Appendix A*);
2. Applicant's Response to Final Office Action, filed January 12, 2005 (*Appendix B*); and
3. U.S. Patent and Trademark Office's Decision on Petition, mailed April 2, 2005 (*Appendix C*).

Please enter the following remarks into the file of the above identified application.

Applicant's Response to final Office Action (*Appendix A*) from the U.S. Patent and Trademark Office (USPTO) dated November 12, 2004 was filed within the two month variable reply period set forth in the final rejection. Pursuant to 37 CFR 1.136(a) the time for the applicant to take further action (including the calculation of extension fees under MPEP 706.07(f)) begins to run three months from the date of the final rejection, or from the date of the advisory action, whichever runs later. In other words, if the Examiner does not mail an advisory action until after the end of the 3-month period, the shortened statutory period will expire on the date the Examiner mails the advisory action and any extension of time fee is calculated from the mailing date of the advisory action. Although Applicants have not yet received the advisory action, the PAIR system indicates that an advisory action was mailed on May 10, 2005. Accordingly, it is respectfully submitted that Applicants need only pay a

one month extension of time, as the shortened statutory period only expires on the date the Examiner mailed the advisory action, *i.e.*, May 10, 2005.

Accordingly, it is respectfully requested that the time for response be extended for a period of one month. The fee for this extension is estimated to be \$110.00. Please charge the required fee to Morgan, Lewis & Bockius LLP Deposit Account No. 50-0310 (order no. 060809-0080-US).

REMARKS

On January 12, 2005 Applicants filed a Petition for Acceptance of Unintentionally Delayed Claim for Priority (*Appendix A*) together with a Response to Final Office Action (*Appendix A*). A Decision on Petition (*Appendix C*) was mailed to Applicants on April 7, 2005. The Decision dismissed the petition by stating:

The petition complies with items (1) through (3) above. however, the examiner has indicated that the proposed amendment would not be entered because the “entry of priority would require a new ground of rejection since it would remove art applied on grounds of rejection as prior art.” Therefore, since the amendment does not *prima facie* place the application in condition for allowance for the reasons indicated by the examiner, petitioner must now submit a Notice of Appeal, a request for continued examination (RCE) under the provisions of 37 CFR 1.114, or file a continuing application pursuant to the provisions of 37 CFR 1.53(b).

(Emphasis added)

In other words, the Office of Petitions acknowledges that all of the required items necessary to comply with the Petition were present, but that the Petition was dismissed as an allowance of the Petition would effectively remove the Examiner’s primary reference as prior art, thereby necessitating a restart of the examination.

Applicants respectfully submit that the Petition was incorrectly dismissed. Rather, the Petition should have been allowed (as the Petition complied with all requirements), and returned to the Examiner. The Examiner’s Advisory Action (which we have not yet seen) may then advise the Applicant that the amendment cannot be entered as “entry of priority would require a new ground of rejection since it would remove art applied on grounds of rejection as prior art.”

In any event, Applicants hereby file an RCE application as suggested by the Lead Petitions Examiner, and request reconsideration of the dismissal of the Petition.

If there are any fees or credits due in connection with the filing of this Amendment, including any fees required for an Extension of Time under 37 C.F.R. Section 1.136,

authorization is given to charge any necessary fees to our Deposit Account No. 50-0310
(order No. 060809-0080-US). A copy of this sheet is enclosed for such purpose.

Respectfully submitted,

Date: May 11, 2005



45,645

Dion M. Bregman

(Reg. No.)

MORGAN, LEWIS & BOCKIUS LLP

2 Palo Alto Square

3000 El Camino Real, Suite 700

Palo Alto, California 94306

(650) 843-4000



Express Mail No.: EV 533 736 026 US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re application of: Liaw *et al.*

Confirmation No.: 2900

Serial No. 09/839,768

Group Art Unit: 2112

Filed: April 19, 2001

Examiner: Myers, Paul R.

For: *High-Frequency Bus System*

Attorney Docket No.: 060809-0080-US

RESPONSE TO FINAL OFFICE ACTION

Mail Stop Amendments
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This response is in reply to the final Office Action from the U.S. Patent and Trademark Office dated November 12, 2004. Please enter the following amendments and remarks into the file of the above identified application.

Pursuant to the ultimate paragraph of this amendment, the Commissioner is authorized to charge any required fees to Morgan, Lewis & Bockius LLP Deposit Account No. 50-0310 (order No. 060809-0080-US).

AMENDMENTS

In the Specification:

On Page 1, after the title, please replace the first paragraph of the specification, namely "This is a continuation of application no. 09/507,303, filed February 18, 2000" with the following paragraph:

This application is a continuation of U.S. Application No. 09/507,303, filed 02/18/2000, now U.S. Patent No. 6,266,730, which is a continuation of U.S. Patent Application No. 08/938,084, filed 09/26/1997, now U.S. Patent No. 6,067,594.

In the Claims:

This listing of claims will replace all prior versions and listings of claims in the application:

1-45. (Previously Cancelled)

46. (Previously Presented) A memory module, comprising:

a first circuit board including a first conductive trace disposed on a surface of the first circuit board;

a first connector including at least one contact connected to the first conductive trace, wherein the first connector is for removably connecting the first circuit board to a second circuit board; and

a first capacitor including:

one capacitor electrode connected to the first connector at a junction where the contact connects to the first conductive trace; and

another capacitor electrode coupled to a node that is at a supply potential.

47. (Previously Presented) The memory module of claim 46, wherein the first connector includes at least one set of edge contacts disposed on the surface.

48. (Previously Presented) The memory module of claim 47, wherein the first connector includes an additional set of edge contacts on another surface substantially parallel to the surface.

49. (Previously Presented) The memory module of claim 46, wherein the contact is a conductive pad disposed on the surface and proximate to an edge of the surface of the first circuit board.

50. (Previously Presented) The memory module of claim 46, wherein the contact is a pin and the first connector comprises a socket for accepting insertion of the second circuit board.

51. (Previously Presented) The memory module of claim 46, wherein the first circuit board is a motherboard and the second circuit board is a daughter board.

52. (Previously Presented) The memory module of claim 46, wherein one of the capacitor electrodes is a conductive pad disposed on the surface of the first circuit board.

53. (Previously Presented) The memory module of claim 46, wherein the supply potential is a ground potential.

54. (Previously Presented) The memory module of claim 46, further comprising a conductive plane disposed parallel to and beneath the surface of the first circuit board, the conductive plane being at a ground potential.

55. (Previously Presented) The memory module of claim 54, further comprising a dielectric disposed between the first conductive trace and the conductive plane.

56. (Previously Presented) The memory module of claim 46, wherein the contact has a first impedance value and the first conductive trace has a second impedance value, wherein the first impedance value is different than the second impedance value.

57. (Previously Presented) The memory module of claim 56, wherein the first capacitor reduces the difference between the first impedance value and the second impedance value.

58. (Previously Presented) The memory module of claim 46, further comprises a plurality of memory devices coupled to the first conductive trace.

59. (Previously Presented) The memory module of claim 46, wherein the first conductive trace comprises a microstrip.

60. (Previously Presented) The memory module of claim 46, wherein a width of a first segment of the first conductive trace is varied with respect to a width of a second segment of the first conductive trace.

61. (Previously Presented) The memory module of claim 60, wherein the width of the first segment is varied with respect to the width of the second segment to reduce a difference

between an impedance value of the first segment and an impedance value of the second segment.

62. (Previously Presented) The memory module of claim 46, further comprising:
the second circuit board;
a second conductive trace disposed on a surface of the second circuit board;
a second connector coupled to the second conductive trace, wherein the second connector mates with the first connector and electrically couples the second conductive trace to the first conductive trace;
a second capacitor including:
one capacitor electrode connected at a junction where the second connector connects to the second conductive trace; and
another capacitor electrode coupled to a node that is at the supply potential.

63. (Previously Presented) The memory module of claim 62, wherein the first circuit board is a motherboard and the second circuit board is a daughter board.

64. (Previously Presented) The memory module of claim 63, wherein a surface of the second circuit board is positioned substantially orthogonal to a surface of the first circuit board.

65. (Previously Presented) The memory module of claim 62, wherein the second capacitor reduces a difference between an impedance value of the second conductive trace and an effective impedance value resulting from the first connector mating with the second connector.

66. (Previously Presented) The memory module of claim 62, wherein the second connector comprises a conductive pad disposed on the surface and proximate to an edge of the second circuit board.

67. (Previously Presented) The memory module of claim 62, wherein the second conductive trace has a right angle turn at each end of the second conductive trace

REMARKS

In the November 12, 2004 Office Action, the Examiner:

- Rejected claims 46-49, 51-54 and 56-58 under 35 U.S.C. 102(e) as being anticipated by Nakase *et al.* ("Nakase", U.S. Pat. No. 6,392,897);
- Rejected claims 50 and 62-67 under 35 U.S.C. 103(a) as unpatentable over Nakase in view of Shepherd ("Shepherd", U.S. Pat. No. 4,781,624;
- Rejected claims 55 and 59 under 35 U.S.C. 103(a) as unpatentable over Nakase in view of Burger *et al.* ("Burger", U.S. Pat. No. 4,788,766; and 4,781,624;
- Rejected claim 60 under 35 U.S.C. 103(a) as unpatentable over Nakase in view of Grisler ("Grisler", U.S. Pat. No. 3,359,510.

On January 10, 2005, the undersigned attorney had a telephone conference with the Examiner regarding the applicability of the primary reference of Nakase as prior art. It was discovered that the USPTO records failed to indicate that the present application claims priority to both U.S. Application No. 09/507,303, filed 02/18/2000 (now U.S. Patent No. 6,266,730) and U.S. patent application no. 08/938,084, filed 09/26/97 (now U.S. Patent No. 6,067,594). Also, the present application is a continuation of U.S. Application No. 09/507,303, which is in turn a continuation of U.S. patent application no. 08/938,084.

Accordingly, pursuant to MPEP 201.11(V) Applicants hereby concurrently submit a Petition For Acceptance Of Unintentionally Delayed Claim For Priority. Should the Petition be granted, the present application will correctly claim priority back to 09/26/97. This will effectively remove the primary reference of Nakase (filed 8/10/1998) as prior art, thereby vitiating the outstanding rejections.

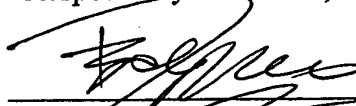
CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is now in a condition for allowance. However, should the Examiner believe that the claims are not in condition for allowance, the Applicant requests that the Examiner call the undersigned attorney at 650-849-7519 to set up an interview.

If there are any fees or credits due in connection with the filing of this Amendment, including any fees required for an Extension of Time under 37 C.F.R. Section 1.136, authorization is given to charge any necessary fees to our Deposit Account No. 50-0310 (order No. 060809-0080-US). A copy of this sheet is enclosed for such purpose.

Respectfully submitted,

Date: January 12, 2005



Dion M. Bregman (Reg. No.) 45,645
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Express Mail No. EV 533 736 026 US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:	Liaw <i>et al.</i>	Confirmation No.:	2900
Serial No.:	09/839,768	Art Unit:	2112
Filed:	April 19, 2001	Examiner:	Myers, Paul R.
For:	<i>High-Frequency Bus System</i>	Attorney Docket No.:	060809-0080-US

PETITION FOR ACCEPTANCE OF UNINTENTIONALLY DELAYED
CLAIM FOR PRIORITY

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sirs:

Applicants petition the Commissioner to correct the domestic priority information on record for the above-identified U.S. patent application. The captioned application is a continuation application of U.S. Application No. 09/507,303, filed 02/18/2000, now U.S. Patent No. 6,266,730, which is a continuation application of U.S. patent application no. 08/938,084, filed 09/26/97, now U.S. Patent No. 6,067,594. Accordingly, pursuant to the Response to Final Office Action submitted concurrently herewith, please replace the first paragraph of the specification, namely "This is a continuation of application no. 09/507,303, filed February 18, 2000" with the following paragraph: "This Application is a continuation of U.S. Application No. 09/507,303, filed 02/18/2000, now U.S. Patent No. 6,266,730, which is a continuation of U.S. patent application no. 08/938,084, filed 09/26/97, now U.S. Patent No. 6,067,594". Such domestic priority information was unintentionally delayed, as outlined below.

BACKGROUND

At the time of filing the captioned application (April 19, 2001), Applicants requested the Commissioner amend the specification by inserting the following priority information before the first paragraph of the specification: "[t]his is a continuation of application no. 09/507,303, filed February 18, 2000". This instruction is found on the "Patent Application Fee Value" sheet, as filed April 19, 2001. Further, an executed Declaration for Patent Application, listing the priority information of both parent cases 09/507,303, filed February

18, 2000 and 08,938,084, filed September 26, 1997, was filed with the patent application on April 19, 2001.

A Filing Receipt was mailed by the Patent Office on May 4, 2001, stating domestic priority as "This Application is a CON of 09/507,303, 02/18/2000". Applicants subsequently filed a Communication with the Patent Office on May 17, 2001, requesting correction of the Filing Receipt to read "This Application is a CON of 09/507,303 02/18/2000, which is a CON of 08/938,084 09/26/97".

An updated Filing Receipt was mailed by the Patent Office on August 17, 2001, but the domestic priority information was not updated to reflect the parent case of 08/938,084 09/26/97. Applicants inadvertently and unintentionally did not request an additional corrected Filing Receipt to correct the domestic priority information.

For ease of reference, Applicants enclose copies of the following documents:

1. Patent Application Fee Value sheet as filed April 19, 2001;
2. Executed Declaration for Patent Application, as filed April 19, 2001;
3. Stamped return postcard from the Patent Office, dated April 19, 2001;
4. Filing Receipt dated May 4, 2001;
5. Communication to the Patent Office requesting correction of the Filing Receipt, as filed May 17, 2001;
6. Stamped return postcard from the Patent Office, showing receipt of the Communication, dated May 17, 2001; and
7. Updated Filing Receipt from the Patent Office dated August 17, 2001.

REMARKS

MPEP 201.11(V)¹ states:

If an applicant includes a claim to the benefit of a prior application elsewhere in the application but not in the manner specified in 37 CFR 1.78(a)(2)(i) and (a)(2)(iii) or 37 CFR 1.78(a)(5)(i) and (a)(5)(iii) (e.g., if the benefit claim is included in an unexecuted oath or declaration or the application transmittal letter) within the time period set forth in 37 CFR 1.78(a)(2)(ii) or (a)(5)(ii), the Office will not require a petition and the surcharge under 37 CFR 1.17(t) to correct the benefit claim if the information concerning the benefit claim contained elsewhere in the application was recognized by the Office as shown by its inclusion on a filing receipt. . . .

If, however, an applicant includes a benefit claim elsewhere in the application and not in the manner specified in 37 CFR 1.78(a), and the claim is not recognized by the Office as shown by its absence on a filing receipt (e.g., if the benefit claim is in a part of the application where benefit claims are not conventionally located, such as the body of the specification), the Office will require a petition and the

¹ MPEP, Rev. 2, May 2004, at Page 200-64.

surcharge under 37 CFR 1.17(t) to correct the benefit claim. This is because the application will not have been scheduled for publication on the basis of the information concerning the benefit claim contained elsewhere in the application. (Emphasis added).

It is respectfully submitted that the present error of the claim to priority is unlike that outlined by the MPEP above. For example, the above section of the MPEP states that the Applicant must Petition the Office and pay the requisite fee, if the Office failed to recognize the claim to priority on the Filing Receipt. However, Applicants noticed the error on the Filing Receipt and requested its correction so as to include both priority claims. Unfortunately, the Office failed to (i) make the correction to the Filing Receipt, and (ii) instruct the Applicant to amend the first sentence of the application to include the reference to the earlier application, as is typically the case. For these reasons alone, it is respectfully requested that the Office waive the fee for this Petition.

Furthermore, as the present application correctly claims priority as a continuation application of U.S. Application No. 09/507,303, and that U.S. Application No. 09/507,303 is a continuation application of U.S. Patent No. 6,266,730, it is respectfully submitted that it should be clear from the Office's records that the present application will automatically claim priority back to the initial patent application, from which both applications are continuation applications, namely U.S. Patent Application No. 09/507,303.

If, however, the Office is unwilling to waive the fee, the Commissioner is nevertheless authorized to charge the \$1,370.00 fee, set forth in 37 CFR 1.17(T) to Morgan, Lewis & Bockius LLP Deposit Account No. 50-0310 (order no. 060809-0080-US). However, as stated above, Applicants believe that since domestic priority information was provided in the Application transmittal, Declaration for Patent Application, and Communication to the Office to correct the filing, no fees should be due.

Respectfully submitted,

Date: January 12, 2005



Dion M. Bregman
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45,645

(Reg. No.)

COPY

PENNIE & EDMONDS LLP DOCKET NO. 9797-0080-999

Express Mail No.: EL 451 596 659 US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Prior application: Examiner R. DhariaArt Unit 2181

Assistant Commissioner for Patents
Box PATENT APPLICATION
Washington, D.C. 20231

Sir:

This is a request for filing a ☒ continuation ☐ divisional application under 37 CFR § 1.53(b), of pending prior application no. 09/507,303 filed on February 18, 2000.

of Haw-Jyh Liaw and David Nguyen

(inventor(s) currently of record in prior application)

for HIGH-FREQUENCY BUS SYSTEM

(title of invention)

1. ☒ The filing fee is calculated below:

PATENT APPLICATION FEE VALUE

TYPE	NO. FILED	LESS	EXTRA	EXTRA RATE	FEE
Total Claims	32	-20	12	\$18.00 each	\$ 216.00
Independent	3	-3	0	\$80.00 each	\$ 0.00
Basic Fee					\$ 710.00
Multiple Dependency Fee If Applicable (\$270.00)					\$ 0.00
Total					\$ 926.00
50% Reduction for Independent Inventor, Nonprofit Organization or Small Business Concern					- \$ 0.00
Total Filing Fee					\$ 926.00

2. ☒ Please charge the required fee to Pennie & Edmonds LLP Deposit Account No. 16-1150 (order no. 9797-0080-999). A copy of this sheet is enclosed.
3. ☒ Amend the specification by inserting before the first line the following sentence: This is a continuation of application no. 09/507,303, filed February 18, 2000.
- 4a. ☐ Transfer the drawings from the prior application to this application and abandon the prior application as of the filing date accorded this

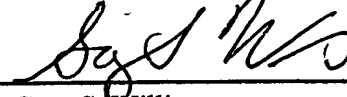
application. A duplicate copy of this sheet is enclosed for filing in the prior application file.

- 4b. ☐ New formal drawings are enclosed.
- 4c. ☐ Informal drawings are enclosed.
- 5a. ☐ Priority of application no. filed on in is claimed under 35 U.S.C. §119.
- 5b. ☐ The certified copy has been filed in prior application no. , filed .
- 6. ☒ The prior application is assigned of record to RAMBUS INC..
- 7a. ☐ The Power of Attorney appears in the original papers in the prior application no. , filed .
- 7b. ☐ Since the Power of Attorney does not appear in the original papers, a copy of the Power in prior application no. , filed is enclosed.
- 8. ☐ This application contains nucleic acid and/or amino acid sequences required to be disclosed in a Sequence Listing under 37 CFR §§1.821-1.825. It is requested that the Sequence Listing in computer readable form from prior application no., filed on be made a part of the present application as provided for by 37 C.F.R. §1.821(e). The sequences disclosed therein are the same as the sequences disclosed in this application. A copy of the paper Sequence Listing from application no. is enclosed.
- 9. ☐ The undersigned states, under 37 C.F.R. §1.821(f), that the content of the enclosed paper Sequence Listing from application no. is the same as the content of the computer readable form submitted in application no. .
- 10. ☒ Additional enclosures or instructions:
 - a copy of the originally filed application and drawings is enclosed;
 - newly executed Declaration by the Inventors, Power of Attorney and Assignment with Recordation Form Cover Sheet is enclosed; and
 - please enter the enclosed Preliminary Amendment before calculating the filing fee.

Respectfully submitted,

Date

4/19/2001



31,066

Gary S. Williams
 PENNIE & EDMONDS LLP
 3300 Hillview Avenue
 Palo Alto, CA 94304
 (650) 493-4935

(Reg. No.)

COPY

DECLARATION FOR PATENT APPLICATION

As a below-named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name,

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled High-Frequency Bus System, the specification of which

(check one) ☒ is attached hereto.

 was filed on as
Application Serial No.
and was amended on .
(if applicable)

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to the examination of this application in accordance with Title 37, Code of Federal Regulations, §1.56(a).

I hereby claim foreign priority benefits under Title 35, United States Code, §119 of any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed:

Prior Foreign Application(s) Priority Claimed

(Number)	(Country)	(Day/Month/Year Filed)	Yes	No
(Number)	(Country)	(Day/Month/Year Filed)	Yes	No

I hereby claim the benefit under Title 35, United States Code, §120 of any United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code, §112, I acknowledge the duty to disclose material information as defined in Title 37, Code of Federal Regulation, §1.56(a) which occurred between the filing date of the prior application and the national or PCT international filing date of this application;

<u>09/507,303</u>	<u>February 18, 2000</u>	<u>pending</u>
(Application Serial No.)	(Filing Date)	(Status)
		(patented, pending, abandoned)
<u>08/938,084</u>	<u>September 26, 1997</u>	<u>patented</u>
(Application Serial No.)	(Filing Date)	(Status)
		(patented, pending, abandoned)
<u> </u>	<u> </u>	<u> </u>
(Application Serial No.)	(Filing Date)	(Status)
		(patented, pending, abandoned)

Direct all telephone calls to Gary S. Williams at (650) 493-4935.

Address all correspondence to:

PENNIE & EDMONDS LLP
3300 Hillview Avenue
Palo Alto, California 94304

File No. 9797-0080-999

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Title 18, United States Code, §1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Full name of sole or
first inventor:

HAW-JYH LIAW

Inventor's signature:

Haw-Jyh Liaw

Date:

3/20/01

Residence:

FREMONT, CALIFORNIA

Citizenship:

TAIWAN

Post Office Address:

40939 CAMERO PLACE

FREMONT, CALIFORNIA 94539

Full name of
second inventor:

DAVID NGUYEN

Inventor's signature:

David Nguyen

Date:

3/16/01

Residence:

SAN JOSE, CALIFORNIA

Citizenship:

U.S.A.

Post Office Address:

1692 LUCCA PLACE

SAN JOSE, CALIFORNIA 95138

COPY

Express Mail No. EL 451 596 659 US First Class Mail () *0-CA*
Date Mailed 4/19/01
Ser. No. To be assigned Filed Herewith
Inventor LIAW and NGUYEN
For HIGH-FREQUENCY BUS SYSTEM

- | | |
|--|---|
| <input checked="" type="checkbox"/> Affidavit Declaration | <input type="checkbox"/> Fee Address Indication Form |
| <input checked="" type="checkbox"/> Amendment - Preliminary | <input type="checkbox"/> Fee Calculation |
| <input checked="" type="checkbox"/> Application <u>26</u> Pages (copy from parent) | <input type="checkbox"/> Issue Fee Transmittal |
| <input checked="" type="checkbox"/> <u>32</u> Claims <u>21</u> Drawings (sheets) | <input type="checkbox"/> Letter |
| <input type="checkbox"/> Appeal, Notice of | <input type="checkbox"/> Oral Hearing Req./Confirm. |
| <input checked="" type="checkbox"/> Assignment | <input type="checkbox"/> Petition to Extend Time |
| <input type="checkbox"/> Brief (in triplicate) | <input type="checkbox"/> Pet. under 37 C.F.R. |
| <input type="checkbox"/> Declaration & Power of Attorney | <input checked="" type="checkbox"/> Power of Attorney |
| <input type="checkbox"/> Design Application | <input type="checkbox"/> Associate <u> </u> w/Revocation |
| <input type="checkbox"/> Disclaimer | <input type="checkbox"/> Sequence Listing w/Computer |
| <input type="checkbox"/> Disclosure Statement | <input type="checkbox"/> Readable and Paper Copies |
| <input type="checkbox"/> w/refs. <input type="checkbox"/> w/o refs. | <input type="checkbox"/> Small Entity Statement |
| <input type="checkbox"/> Drawings Formal | <input type="checkbox"/> Status Letter |
| <input type="checkbox"/> <u> </u> Sheets <u> </u> Figures | <input checked="" type="checkbox"/> Transmittal Letter for Continuation Application |

J1033 U.S. PTO
09/839768
04/19/01

Other: Recordation Form Cover Sheet

File No. 9797-0080-999 Sender: GSW/bj

COPY



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

APPLICATION NUMBER	FILING DATE	GRP ART UNIT	FIL FEE REC'D	ATTY. DOCKET NO	DRAWINGS	TOT CLAIMS	IND CLAIMS
09/839,768 ✓	04/19/2001 ✓	2181 ✓	926	9797-0080-999	21	32 ✓	3 ✓

CONFIRMATION NO. 2900

FILING RECEIPT



OC000000006041464

PENNIE & EDMONDS LLP
3300 Hillview Avenue
Palo Alto, CA 94304

RECEIVED RECORDS

MAY 09 2001
65W 28915
& DOCKETING CA OFFICE

Date Mailed: 05/04/2001

Receipt is acknowledged of this nonprovisional Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination's Customer Service Center. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).

Applicant(s)

Haw-Jyh Liaw, Fremont, CA; ✓
David Nguyen, San Jose, CA; ✓

Assignment For Published Patent Application

RAMBUS INC.;

Domestic Priority data as claimed by applicant

THIS APPLICATION IS A CON OF 09/507,303 02/18/2000 ✓

Foreign Applications

If Required, Foreign Filing License Granted 05/03/2001

Projected Publication Date: To Be Determined - pending completion of Corrected Papers

Non-Publication Request: No

Early Publication Request: No

Title

COPY

Express Mail No. EL 451 596 818 US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Liaw et al.

Serial No.: 09/839,768

Group Art Unit: 2181

Filed: April 19, 2001

Examiner: To be assigned

For: High-Frequency Bus System

Attorney Docket No.: 9797-0080-999

COMMUNICATION

Assistant Commissioner for Patents
Washington D.C. 20231

Sir:

Applicant respectfully requests correction of the Filing Receipt for the referenced application as follows:

Domestic Priority data as claimed by applicant: should read "THIS APPLICATION IS A CON OF 09/507,303 02/18/2000, WHICH IS A CON OF 08/938,084 09/26/97".

TITLE should read "HIGH-FREQUENCY BUS SYSTEM".

Correction of the errors is respectfully requested. A copy of the filing receipt is enclosed.

The Commissioner is authorized to charge any fees associated with this communication to our deposit account number 16-1150 (order no. 9797-0080-999). A copy of this sheet is enclosed for such purpose.

Respectfully submitted,

PENNIE & EDMONDS LLP

By:




Gary S. Williams

Registration No. 31,066

3300 Hillview Avenue
Palo Alto, CA 94304
(650) 849-7721 or (650) 493-4935

COPY

Express Mail No. EL 451 596 818 US First Class Mail ()
Date Mailed May 17, 2001
Ser. No. 09/839,768 Filed 4/19/01
Inventor Liao et al.
For HIGH-FREQUENCY BUS SYSTEM

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|---|--|
| () Affidavit/Declaration | () Fee Address Indication Form |
| () Amendment | () Fee Calculation |
| () Application <u> </u> Pages | () Issue Fee Transmittal |
| () <u> </u> Claims <u> </u> Drawings | () Letter |
| () Appeal, Notice of | () Oral Hearing Req./Confirm. |
| () Assignment | () Petition to Extend Time |
| () Brief (in triplicate) | () Pet. under 37 C.F.R. |
| () Declaration & Power of Attorney | () Power of Attorney |
| () Design Application | <u> </u> Associate <u> </u> w/Revocation |
| () Disclaimer | () Sequence Listing w/Computer |
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| () w/refs. (X) w/o refs. | () Small Entity Statement |
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Other: PTO-1449; postcard; Communication (dupl); copy of
Filing Receipt
File No. 9797-0080-999 Sender: GSW/ab

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Page 1 of 3 ✓

**UNITED STATES PATENT AND TRADEMARK OFFICE**COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

APPLICATION NUMBER	FILING DATE	GRP ART UNIT	FIL FEE REC'D	ATTY. DOCKET NO.	DRAWINGS	TOT CLAIMS	IND CLAIMS
09/839,768 ✓	04/19/2001 ✓	2181 ✓	926	9797-0080-999	21	32	3

CONFIRMATION NO. 2900 ✓

UPDATED FILING RECEIPT

OC000000006443683

PENNIE & EDMONDS LLP
3300 Hillview Avenue
Palo Alto, CA 94304

Date Mailed: 08/17/2001

Receipt is acknowledged of this nonprovisional Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination's Customer Service Center. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).

Applicant(s)✓ Haw-Jyh Liaw, Fremont, CA;
✓ David Nguyen, San Jose, CA;**Assignment For Published Patent Application**

RAMBUS INC.; ✓

Domestic Priority data as claimed by applicant

THIS APPLICATION IS A CON OF 09/507,303 02/18/2000 PAT 6,266,730 ✓

Foreign Applications

If Required, Foreign Filing License Granted 05/03/2001

Projected Publication Date: 11/29/2001

Non-Publication Request: No

Early Publication Request: No

Title

High frequency bus system ✓

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PENNIE & EDMONDSAUG 2 2001
GSIW-24M
CA OFFICE

Data entry by : HAPPY, MILAGROS

Team : OIPE

Date: 08/17/2001



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Title 37, Code of Federal Regulations, 5.11 & 5.15

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PLEASE NOTE the following information about the Filing Receipt:

- o The articles such as "a," "an" and "the" are not included as the first words in the title of an application. They are considered to be unnecessary to the understanding of the title.
- o The words "new," "improved," "improvements in" or "relating to" are not included as first words in the title of an application because a patent application, by nature, is a new idea or improvement.
- o The title may be truncated if it consists of more than 500 characters (letters and spaces combined).
- o The docket number allows a maximum of 25 characters.
- o If your application was submitted under 37 CFR 1.10, your filing date should be the "date in" found on the Express Mail label. If there is a discrepancy, you should submit a request for a corrected Filing Receipt along with a copy of the Express Mail label showing the "date in."
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 Office of Initial Patent Examination
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 Washington, DC 20231

SUPPLEMENTAL APPLICATION DATA SHEET UNDER 37 C.F.R. § 1.72

COPY

Application Information:

Application Number: 09/839,768
Filing Date: April 19, 2001
Title of Invention: HIGH-FREQUENCY BUS SYSTEM
Confirmation No.: 2900
Attorney Docket No.: 060809-0080-US

Inventor Information:

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City: San Jose
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Country: U.S.A.
Zip Code: 95138

Title: HIGH-FREQUENCY BUS SYSTEM

Domestic Priority: This application is a continuation of U.S. Application No. 09/507,303, filed 02/18/2000, now U.S. Patent No. 6,266,730, which is a continuation of U.S. Patent Application No. 08/938,084, filed 09/26/1997, now U.S. Patent No. 6,067,594.

Correspondence Information:

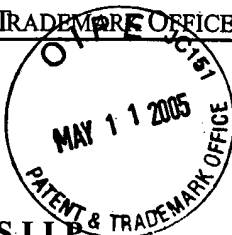
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Fax Number: (650)843-4001

60809-0080-US
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3000 EL CAMINO REAL
PALO ALTO, CA 94306

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APR 07 2005

OFFICE OF PETITIONS

In re Application of
Haw-Jyh Liaw et al
Application No. 09/839,768
Filed: April 19, 2001
Attorney Docket No. 60809-0080-us

:
:DECISION ON PETITION
:UNDER 37 CFR 1.78(a)(3) AND
:37 CFR 1.183
:

This is a decision on the petition under 37 CFR 1.78(a)(3), filed January 12, 2005, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of the prior-filed nonprovisional application set forth in the amendment filed concurrently with the instant petition. This also being treated under 37 CFR 1.183 requesting waiver of 37 CFR 1.78(a)(3) "as that rule operates in conjunction with 37 CFR 1.17(t)."

The petition considered under 37 CFR 1.78(a)(3) is **DISMISSED**.

The petition considered under 37 CFR 1.183 is **DISMISSED**.

WITH RESPECT TO THE PETITION UNDER 37 CFR 1.78(a)(3):

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

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APR 15 2005

MORGAN LEWIS
PALO ALTO OFFICE

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notice of appeal 3rd 12 MAY 2005

The petition complies with items (1) through (3) above. However, the examiner has indicated that the proposed amendment would not be entered because the "entry of claim of priority would require a new grounds of rejection since it would remove art applied on grounds of rejection as prior art." Therefore, since the amendment does not *prima facie* place the application in condition for allowance for the reasons indicated by the examiner, petitioner must now submit a Notice of Appeal, a request for continued examination (RCE) under the provisions of 37 CFR 1.114, or file a continuing application pursuant to the provisions of 37 CFR 1.53(b).

Any request for reconsideration of this decision must be accompanied by a cover letter entitled "Renewed Petition under 37 CFR 1.78(a)(3)" and must include the appropriate reply to continue prosecution of the instant application.

**WITH RESPECT TO WAIVER OF THE SURCHARGE REQUIRED BY 37 CFR
1.78(a)(3)(ii) AND 37 CFR 1.17(t).**

Petitioner requests under 37 CFR 1.183 waiver of the applicable surcharge under 37 CFR 1.78(a)(3)(ii) for the acceptance of an unintentionally delayed claim for priority under 35 U.S.C. § 120 as set forth in 37 CFR 1.17(t). In this regard, petitioner states that this is an extraordinary situation where waiver of the applicable fee is justified since "the Office failed to (i) make the correction to the Filing Receipt, and (ii) instruct the Applicant to amend the first sentence of the application to include the reference to the earlier application, as is typically the case."

APPLICABLE RULE

37 CFR 1.78(a)(2)(i), (ii) and (iii) provides:

(2)(i) Except for a continued prosecution application filed under § 1.53(d), any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior filed copending nonprovisional applications or international applications designating the United States of America must contain or be amended to contain a reference to each such prior application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date and indicating the relationship of the applications. Cross references to other related applications may be made when appropriate (see § 1.14).

(ii) This reference must be submitted during the pendency of the later-filed application. If the later-filed application is an application filed under 35 U.S.C. 111(a), this reference must also be submitted within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed application. If the later-filed

application is a nonprovisional application which entered the national stage from an international application after compliance with 35 U.S.C. 371, this reference must also be submitted within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) in the later-filed international application or sixteen months from the filing date of the prior-filed application. These time periods are not extendable. Except as provided in paragraph (a)(3) of this section, the failure to timely submit the reference required by 35 U.S.C. 120 and paragraph (a)(2)(i) of this section is considered a waiver of any benefit under 35 U.S.C. 120, 121, or 365(c) to such prior-filed application. The time periods in this paragraph do not apply if the later-filed application is:

(A) An application for a design patent;

(B) An application filed under 35 U.S.C. 111(a) before November 29, 2000;
or

(c) A nonprovisional application which entered the national stage after compliance with 35 U.S.C. 371 from an international application filed under 35 U.S.C. 363 before November 29, 2000.

(iii) If the later-filed application is a nonprovisional application, the reference required by this paragraph must be included in an application data sheet (§ 1.76), or the specification must contain or be amended to contain such reference in the first sentence following the title.

(iv) The request for a continued prosecution application under § 1.53(d) is the specific reference required by 35 U.S.C. 120 to the prior-filed application. The identification of an application by application number under this section is the identification of every application assigned that application number necessary for a specific reference required by 35 U.S.C. 120 to every such application assigned that application number.

(3) If the reference required by 35 U.S.C. 120 and paragraph (a)(2) of this section is presented in a nonprovisional application after the time period provided by paragraph (a)(2)(ii) of this section, the claim under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed copending nonprovisional application or international application designating the United States of America may be accepted if the reference identifying the prior-filed application by application number or international application number and international filing date was unintentionally delayed. A petition to accept an unintentionally delayed claim under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed application must be accompanied by:

- (i) The reference required by 35 U.S.C. 120 and paragraph (a)(2) of this section to the prior-filed application, unless previously submitted;
- (ii) The surcharge set forth in § 1.17(f); and
- (iii) A statement that the entire delay between the date the claim was due under paragraph (a)(2)(ii) of this section and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

37 CFR 1.183 states that:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Commissioner or the Commissioner's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

OPINION

In order to grant any petition under 37 CFR 1.183, petitioner must show (1) that this is an extraordinary situation where (2) justice requires waiver of the rule. In re Sivertz, 227 U.S.P.Q. 255, 256 (Comm'r Pat. 1985). Petitioner has not shown that either condition exists in this case.

The circumstances of this case do not demonstrate an extraordinary situation, much less one where justice requires waiver of the rules. In this regard, petitioner failed to follow the rules pertaining to the proper procedure for filing an amendment to insert a claim for priority. More specifically, the proper procedure would have been to file an amendment in compliance with 37 CFR 1.121 instructing the Office to insert the claim for priority in the first sentence of the specification following the title or include the claim for priority in an Application Data Sheet (ADS) as provided by 37 CFR 1.76(b)(5), and not in a declaration. *See* 37 CFR 1.78(a)(2)(iii). Further, the claim for priority in the declaration was improper since there must be a relationship stated; i.e., whether the application is a continuation, division, or continuation-in-part. While the Office attempts to notify applicants of deficiencies in actions in a manner permitting a timely correction, the Office has no obligation to notify parties of deficiencies in their actions in a manner permitting a timely correction. *See In re Sivertz, supra; see also In re Colombo, Inc.*, 33 USPQ2d 1530, 1532 (Comm'r Pat. 1994). Rather, it is ultimately the responsibility of the applicants to ensure that a proper and timely submission is submitted so as to avoid having to file a petition to effect correction of the omission or deficiency. Colombo, Id. Therefore, the failure to timely submit a proper claim for priority of the earlier application within the time period set forth in 37 CFR 1.78(a)(ii) was a circumstance entirely within petitioner's control, and could

have been avoided by the exercise of reasonable care and diligence. Equitable powers should not be invoked to excuse the performance of a condition by a party that has not acted with reasonable, due care and diligence. U.S. v. Lockheed Petroleum Services, 709 F.2d 1472, 1475 (Fed. Cir. 1983).

Furthermore, since the USPTO did not cause or contribute to petitioner's filing delay, this case is even further removed from consideration as one where "justice requires" equitable relief. See Helfgott & Karras, P.C. v. Dickinson, 209 F.3d 1328, 54 USPQ2d 1425 (Fed. Cir. 2000).

Further, petitioner's failure to comply with the requirements of the rules or procedures before the USPTO is not deemed to be an extraordinary situation that would warrant waiver of the rules or procedures under 37 CFR 1.183. See Honigsbaum v. Lehman, 903 F. Supp. 8, 37 USPQ2d 1799 (D.D.C. 1995).

Petitioner overlooks that his failure to timely file a proper claim for benefit of the earlier filed application under 35 U.S.C. § 120 constituted a *waiver* of his right to claim such benefit of priority. See 35 U.S.C. § 120 ("the Director may consider the failure to submit such [a claim] within that time period as a waiver of any benefit under this section"); 37 CFR 1.78(a)(2)(ii); *Cong. Rec.* S14719 (Nov. 17, 1999). Fortunately for petitioner, however, he may now seek reinstatement of his unintentionally waived right, subject, however, to payment of the very surcharge of which petitioner now complains. See 35 U.S.C. § 120, last sentence; 37 CFR 1.78(a)(3); *Cong. Rec.*, supra. That is, since petitioner now desires to be entitled to the potential benefits of the earlier application via § 120, then petitioner must also accept the consequences attendant to that action. See Abbott Laboratories v. Novopharm Ltd., 38 USPQ2d 1309, 1312 (D.C. N. II. 1996), *aff'd* 104 F.3d. 1305, 41 USPQ2d 1535 (Fed. Cir. 1997).

As authorized, the \$1,370 fee required by 37 CFR 1.78(a)(3)(ii) and the \$400 fee required by 37 CFR 1.183 will be charged to petitioner's Deposit Account No. 50-0310.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITIONS
 Commissioner for Patents
 Post Office Box 1450
 Alexandria, VA 22313-1450

By hand: Customer Service Window
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

By fax: (703) 872-9306
 ATTN: Office of Petitions

Any questions concerning this matter may be directed to Wan Laymon at (571) 272-3220.

A handwritten signature in cursive script that reads "Frances Hicks".

Frances Hicks

Lead Petitions Examiner

Office of Petitions

Office of the Deputy Commissioner
for Patent Examination Policy